



EL 964825623US

02-28-05

ITN/DOE

PATENT

Docket No.: ST01023-US-CNT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Benavides, Jesus et al.

Examiner: Not yet assigned

Art Unit: 1614

Serial No.: 10/786,810

Filed: February 25, 2004

Title: **Combination of CB1 Receptor
Antagonist and of a Product which
Activates Dopaminergic
Neurotransmission in the Brain, the
Pharmaceutical Compositions
Comprising Them and Their Use in the
Treatment of Parkinson's Disease**

I hereby certify that this correspondence is being
deposited with the United States Postal Service as
Express Mail in an envelope addressed to Mail Stop:
Petition, Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450, on

2-25-05
Date of Deposit

Signature

EL 964825623 US
Express Mail Certificate

**PETITION UNDER 37 C.F.R. § 1.181 TO REVIEW
RESPONSE TO REQUEST FOR CORRECTED FILING
RECEIPT**

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION

Applicants respectfully petition pursuant to the "Response to Request for Corrected Filing Receipt" issued by the USPTO in the above-identified patent application on August 16, 2004 for the reasons set forth below and request to delete duplicate entry of one of the inventors for the reasons set forth below.

STATEMENT OF THE FACTS

Pursuant to 37 C.F.R. § 1.181(b), Applicants respectfully state that the following sets forth the procedural events that occurred before the United States Patent and Trademark Office in the above-identified patent application:

1. The above identified patent application was filed on February 25, 2004 in accordance with the procedures as set forth in 37 C.F.R. § 1.53(b). The application was then

assigned the serial no. 10/786,810 by the USPTO (see attached Response to Request for Corrected Filing Receipt, Exhibit A).

2. Applicants further assert that a duly executed declaration by the inventors in the above-identified application was submitted following the issuance of a "Notice to File Missing Parts of Application – Filing Date Granted" on June 22, 2004 (see Exhibit B).
3. There are four inventors named in this application. One of the inventors, Yvette Henin, found the address on the declaration to be incorrect and decided to cross-it out and hand wrote the correct address and signed on May 20, 2004. At the same time, inadvertently, Yvette Henin decided to re-write only his last name at a blank space (inventor 5) and signed again with his new address.
4. Because of this inadvertent error, the Office issued a Corrected Filing Receipt by including Yvetter Henin twice, once with his full name and again with his last name only, see copy of Corrected Filing Receipt enclosed (Exhibit C). Furthermore, the Office also issued the above noted Response to Request for Corrected Filing Receipt, Exhibit A.

POINTS TO BE REVIEWED

1. From the foregoing "Statement of Facts," it is respectfully submitted that Applicants have fully complied with all of the provisions in accordance with 37 C.F.R. § 1.53(b).
2. The duplicate entry of address and signature by inventor, Yvette Henin was an inadvertent error, thus resulting in listing him twice on the list of applicants in the Corrected Filing Receipt.

ACTION REQUESTED

Applicants respectfully request the Commissioner to delete one of the duplicate entries of inventor Henin in the list of applicants and issue a Corrected Filing Receipt.

The Commissioner is authorized to charge any fees under 37 C.F.R. 1.17(i) which may be required by this paper or credit any overpayment to **Deposit Account No. 18-1982**

Application Ser. No.: 10/786,810
Filing Date: February 25, 2004

for Aventis Pharmaceuticals, Inc., Bridgewater, NJ. Please credit any overpayment to **Deposit Account No. 18-1982**. A duplicate copy of this transmittal letter is enclosed for accounting purposes.

Respectfully submitted,

February 25, 2005

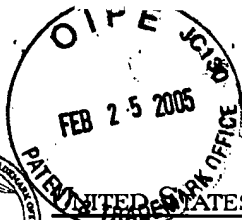


Balaram Gupta, Reg. No. 40,009
Attorney/Agent for Applicant

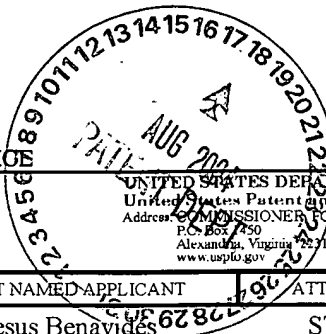
Encl: Copies of Exhibits A – C.

Aventis Pharmaceuticals Inc.
Patent Department
Route #202-206 / P.O. Box 6800
Bridgewater, NJ 08807-0800
Telephone: 908-231-3364
Telefax: 908-231-2626

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 7450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

| APPLICATION NUMBER | FILING OR 371(c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|-----------------------|-----------------------|------------------------|
| 10/786,810 | 02/25/2004 | Jesus Benavides | ST01023 US CNT |

CONFIRMATION NO. 3346

005487
 ROSS J. OEHLER
 AVENTIS PHARMACEUTICALS INC.
 ROUTE 202-206
 MAIL CODE: D303A
 BRIDGEWATER, NJ 08807



OC000000013550904

Date Mailed: 08/16/2004

RESPONSE TO REQUEST FOR CORRECTED FILING RECEIPT


Claims, Fees, and Inventors

In response to your request for a corrected Filing Receipt, the Office is unable to comply with the request because:

- ☐ The total number of claims appearing on the Filing Receipt does not include multiple dependent claims. The total fee appearing on the Filing Receipt includes the cost of multiple dependent claims that were present at the time the application was filed.
- ☐ The filing fee is correct. It may include additional claims fees and/or the surcharge under 37 CFR 1.16 (e) for filing an oath/declaration or basic filing fee after the application filing date; or it may not reflect fees refunded to the applicant that were paid by mistake.
- ☐ The number of claims reflected on the filing receipt is correct. Upon review of the claims, it was found that there was a miscalculation by the applicant. This may be due to improperly presented multiple dependent claims, typographical error, misnumbering of the claims, or other oversight. An amendment may be necessary to correct the problem.
- ☐ The filing fee reflected on the filing receipt is correct. Applicant may have miscalculated the fees due.
- ☐ Applicant calculated fees as other than small entity; however, applicant asserted small entity status in the application. Therefore, fees were applied as small entity and the remainder was refunded to the applicant.
- ☐ The difference between the fees paid and the fees due was refunded to the applicant and will not be shown on the filing receipt.
- ☐ The inventor information may be truncated if the family name consists of more than 50 characters

(letters and spaces combined) and if the given name consists of more than 50 characters (letters and spaces combined).

- ☐ The inventor's residence allows for up to 40 characters (letters and spaces combined).
- ☐ The inventor's residence will only include the city and state for U.S. residences or city and country for residences outside the U.S. (See MPEP 605.02).
- ☒ A petition to correct the inventorship is needed to make this change. See 37 CFR 1.48. For non-provisional applications, the petition should be directed to the Director of the examining group assigned to your application.
- ☐ Changes made after submission of an executed declaration to the inventor information other than correction of typographical errors must be submitted in the form of a substitute declaration. Change of inventorship requires a petition under 37 CFR 1.48.
- ☐ The number of drawings shown on the filing receipt reflects the number of drawing sheets submitted and is not necessarily equal to the number of figures submitted.
- ☐ The correspondence address was captured as directed by applicant on filing. If you wish correspondence to be directed otherwise, please submit a request for a change of address.
- ☐ The docket number allows a maximum of 25 characters.
- ☐ The person signing on behalf of the deceased inventor is reflected on the Filing Receipt as the legal representative.
- ☐ The filing date of a parent application cannot be changed by this request. A petition to correct the filing date in the parent application is required.



 Customer Service Center
 Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

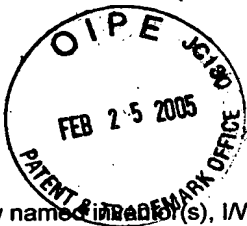


EXHIBIT B

UNITED STATES OF AMERICA

**DECLARATION
FOR PATENT APPLICATION**

As a below named inventor(s), I/We hereby declare that:

My/Our residence(s), post office address(es) and citizenship(s) are as stated below my name(s).
I/We verily believe I am/we are the original, first and sole/joint inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**COMBINATION OF A CB1 RECEPTOR ANTAGONIST AND OF A PRODUCT WHICH ACTIVATES
DOPAMINERGIC NEUROTRANSMISSION IN THE BRAIN, THE PHARMACEUTICAL COMPOSITIONS
COMPRISING THEM AND THEIR USE IN THE TREATMENT OF PARKINSON'S DISEASE**

and the specification of which ☐ is attached hereto (Aventis Docket No. ST01023 US CNT)
(check one) ☒ was filed on **February 25, 2004** as U.S. Application Number **10/786,810**
and was amended on (if applicable).
☐ was described and claimed in PCT Int'l Application Number filed on
and as amended under PCT Article 19 on (if any).

I/We hereby state that I/We have reviewed and understand the contents of the above identified specification, including the claims as amended by any amendment referred to above.
I/We acknowledge the duty to disclose to the U.S. Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 C.F.R. 1.56.

☒ I/We hereby claim foreign priority benefits under Title 35, United States Code §119(a)-(d) or 365 (b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one other country other than the United States of America, listed below and having a filing date before that of the application on which priority is claimed. I/We have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Foreign Priority: **0111200** **France** **29/August/2001**
Number Country Day/Month/Year Filed

Prior Foreign Appln(s): Number Country Day/Month/Year Filed

☐ I/We hereby claim the benefit under Title 35, United States Code §119(e) of any United States Provisional application(s) listed below:

Number Filing Date

☒ I/We hereby claim the benefit under Title 35, United States Code §120 or 365(c) of any United States application(s) or international application designating the United States listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code §112, I/We acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

PCT/FR02/02946 **August 28, 2002** **Pending**
Application Serial No. Filing Date Status (Patented, Pending)

I/We hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Title 18, United States code §1001, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Inventors(s): ☒ Additional names and signatures are attached.

1. Full name: **Jésus BENAVIDES**

Signature: Jésus Benavides

Date: 30 March 2004

Country of Citizenship: **Spain**

Residence: **Chatenay Malabry, France**
(City, State/City, and Country only)

P. O. Address: **105 rue Anatole France**
92290 Chatenay Malabry (France)

2. Full name: **Daniel BOCCIO**

Signature: Daniel Boccio

Date: 8 April 2004

Country of Citizenship: **France**

Residence: **Pringy, France Fauq. Billor, France**
(City, State/City, and Country only)

P. O. Address: **27 rue de Lourdeau 14 rue Georges Darboy**
77310 Pringy (France) 52500 Fauq. Billor
(France)

3. Full name: Yvette HENIN

Signature: [Signature]

Date: 20 Nov 2004

Country of Citizenship: France

Residence: Paris, France
(City, State/City, and Country only)

P. O. Address: 12, rue duchefdelaville 18^{ème} arr^t
75013 Paris (France) 75019

4. Full name: Odile PIOT-GROSJEAN

Signature: [Signature]

Date: 7th April 2004

Country of Citizenship: France

Residence: Choisy Le Roi, France
(City, State/City, and Country only)

P. O. Address: 4 rue Jean-Baptiste Clément
94600 Choisy Le Roi (France)

5. Full name: HENIN

Signature: [Signature]

Date: 05/20/2004

Country of Citizenship: France

Residence: Paris
(City and State/City and Country only)

P. O. Address: 12^{ème} arr^t 75019 Paris

6. Full name: _____

Signature: _____

Date: _____

Country of Citizenship: _____

Residence: _____
(City and State/City and Country only)

P. O. Address: _____

Customer No. 005487

Aventis Pharmaceuticals Inc.
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P.O. Box 6800
Mail Code D-303A
Bridgewater, NJ 08807-0800
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Aventis Docket No. ST01023 US CNT

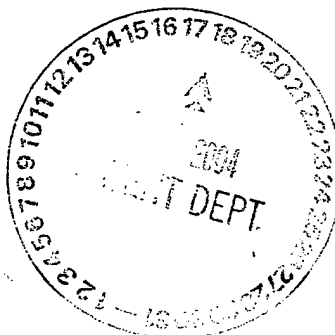
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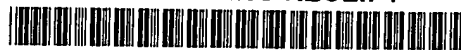
| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|------------|---------------------------|----------|---------------|----------------|----------|----------|----------|
| 10/786,810 | 02/25/2004 | 1614 | 1188 | ST01023 US CNT | | 36 | 1 |

005487
ROSS J. OEHLER
AVENTIS PHARMACEUTICALS INC.
ROUTE 202-206
MAIL CODE: D303A
BRIDGEWATER, NJ 08807

B. Gupta



CORRECTED FILING RECEIPT



OC000000013550897

COMPUTER ENTERED

8/19/04

Date Mailed: 08/16/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Jesus Benavides, Chatenay Malabry, FRANCE;
Daniel Boccio, Fay P. Bippov, FRANCE;
Yvette Henin, Paris, FRANCE;
Odile Piot-Grosjean, Choisy Le Roi, FRANCE;
~~Henin, Paris, FRANCE;~~

Aventis Pharma S.A., Cedex, FRANCE:

⇒ Aventis Pharma S.A., Antony Cedex
France

This application is a CON of PCT/FR02/02946 08/28/2002

FRANCE 0111200 08/29/2001

If Required, Foreign Filing License Granted: 05/17/2004

Projected Publication Date: 10/21/2004

Non-Publication Request: No

Early Publication Request: No

Title

Combination of a CB1 receptor antagonist and of a product which ^{Activates} activates dopaminergic neurotransmission in the brain, the pharmaceutical compositions comprising them and their use in the treatment of parkinson's disease

Preliminary Class

514

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).